REMARKS

Claims 1, 3-6, 8-10, 12-18, and 20-22 are now pending in the present application. By the present action, claims 2, 7, 11, and 19 are canceled; claims 1, 4, 10, 14, and 17 are amended; and claims 20-22 are added. Reconsideration of the claims is respectfully requested.

The amendments to the independent claims is supported as follows: the request containing a number that is used as a highest ranking requested is shown in Figure 5, reference number 80 and discussed on page 10, lines 12-14. The step of selecting the musical pieces having given numerical rankings is discussed, for example, on page 13, lines 2-25. Finally, the step of determining music data to be downloaded page 14, lines 8-20.

I. Examiner Interview

The Examiner is thanked for the courtesy of an interview in which the invention and various amendments to the claims were discussed. Amendments included in claims 1 and 10, as well as new independent claim 20, were discussed.

II. 35 U.S.C. § 103, Obviousness: Claims 1-19

Claims 1-19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over **Mastronardi** et al., Device and Process for Remote Management of a Network of Audiovisual Information Reproduction Systems, U.S. Patent No. 6,578,051, June 10, 2003 (hereinafter "**Mastronardi**") in view of **Chiu** et al., Methods and Apparatuses for Transferring Data Between Data Processing Systems Which Transfer a Representation of the Data Before Transferring the Data, U.S. Patent No. 6,076,111, June 13, 2000 (hereinafter "**Chiu**"). This rejection is respectfully traversed.

The rejection states on pages 2-3 of the Office Action dated November 28, 2005, that:

> 4. As per claim 1, Mastronardi discloses a music distribution method for downloading, in response to a request from a user, music data for one more musical pieces (i.e.: songs)included in the latest hit charts (i.e.: an album) from a server storing lot of music data, comprising the steps of: Mastronardi also discloses determining if the information in database needs to be updated [Mastronardi, col 7 line 42-col 8 line 30; col 24 lines 22-37]; and downloaded any new songs [Mastronardi, col 8 lines 30-46; col 11 lines 1-31; col 21 line 60-col 22 line 14]. However, Mastronardi does not explicitly detail determining whether music data to be downloaded from said server are already

> stored in a terminal said user and downloading, from said server to said terminal, only music data that are not stored in said terminal.
>
> In the same endeavor, Chiu discloses a multimedia web server downloads a page (i.e.: isochronous data, audio, video) in the album, compares and stored [Chiu, col 5 lines 1-45] and determines that the selected identifier is not already used or a new media container [Chiu, col 6 lines 32-58]
>
> Therefore it would have been obvious to an ordinary skill in the art at the time the invention was made to take advantage of the server determined the selected identifier (i.e.: filename, song title) is not used as taught by Chiu into the Mastronardi's apparatus in order to utilize the download process. Doing so would eliminate the transfer data unnecessary between client and server.

Office Action dated November 28, 2005, pages 2-3.

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

Amended claim 1 recites:

> 1. (Amended) A music distribution method for downloading, in response to a request from a user, music data for one or more musical pieces included in a given latest hits chart from a server storing a lot of music data, comprising the computer-implemented steps of:
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> receiving said request at said server, wherein said request contains a chosen number associated with a given latest hits chart;
>
> on said given latest hits chart, selecting musical pieces that have a numerical ranking not greater than said chosen number;
>
> for each musical piece selected, determining music data to be downloaded, said music data associated with respective selected musical pieces;
>
> determining whether music data to be downloaded from said server are already stored in a terminal of said user; and
>
> downloading, from said server to said terminal, only music data that are not stored in said terminal.

The rejection acknowledges that **Mastronardi** does not show the determining step of claim 1, but asserts that this step is shown in **Chiu** and that the combination would be obvious because it would eliminate the unnecessary transfer of data between client and server. However, the assertion that the combination would be obvious is contrary to the thrust of **Mastronardi**. **Mastronardi** states:

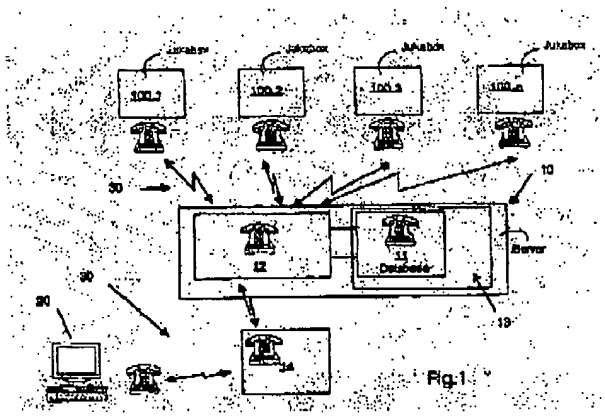


FIG. 1 shows a block diagram of the device according to the invention. According to prior art, each audiovisual reproduction device (100.1 to 100.n) communicates with the host server 10 through its telecommunication means, and for example a modem card 41 connected to the telephone network 30. The host server 10 comprises communication means 121, 111 for this purpose, for example such as at least one modem connected to the telephone network. The host server 10 also comprises a database 11 containing all information about the operation of each audiovisual information reproduction device (100.1 to 100.n), in other words the operating parameters for the audiovisual information reproduction device (100.1 to 100.n), its identification number, the list of songs stored on each audiovisual information reproduction device (100.1 to 100.n), each operator being responsible for management of one group of audiovisual information reproduction device(s) (100.1 to 100.n).

Mastronardi, col. 6, lines 15-29 emphasis added

Mastronardi discloses a centralized system to manage a number of jukeboxes via an electronic connection. Because the control is centralized, **Mastronardi** maintains a list of songs stored on each jukebox in its own centralized database. If **Mastronardi** needs to know the songs stored on a given jukebox, it has that information in its memory.

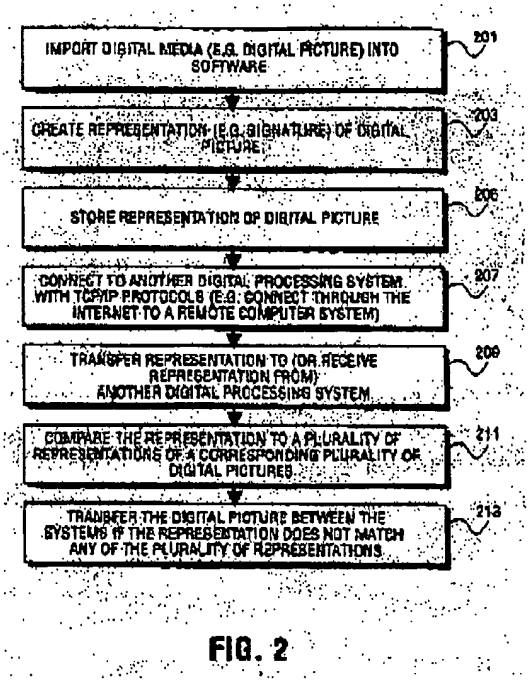


FIG. 2

In contrast, **Chiu** requires that the two processing systems must connect to each other in order to determine whether or not the information to be passed from the first system is already present on the second system. This is shown in steps 207-211 of Figure 2 of **Chiu**, reproduced here. Contrary to the assertion in the rejection, adding this capability of **Chiu's** to **Mastronardi** would require that more information be transmitted [i.e., a representation of the information to be sent for comparison], not less. Therefore the motivation to combine **Chiu** is not one that would be used by one of ordinary skill in the art.

Additionally, new features have been added to claim1 to further clarify the invention. None of the references relied on show the newly added feature of "*wherein said request contains a chosen number associated with a given latest hits chart*", as recited in claim 1. Neither do references relied on show the feature of "*selecting musical pieces that have a numerical ranking not greater than said chosen number*".

Additionally, one of ordinary skill in the art would not combine the references when they are considered as a whole. In considering the references as a whole, one of ordinary skill in the art would look at the problems recognized and solved. **Mastronardi** is directed towards managing a group of jukeboxes whose songs need to change periodically, noting that in the prior art, "*Management of orders for new songs and for changing settings requires either that an operator should visit the site on which the jukebox is installed, or that the operator should use a computer with a link to the host server. Furthermore, management operations that can be performed through the link with the host server are limited to ordering new musical selections*" (**Mastronardi**, column 1, lines 21-29). In contrast, **Chiu** recognizes problems with the transfer of excess data, noting, "*These prior approaches to transferring data often result in the transmission of unnecessary data between the computer system*" (**Chiu**, column 1, lines 38-40). These two problems are entirely unrelated and one of ordinary skill in the art would not be motivated to combine these two references when they are read a whole. As further support, the

two cited references provide entirely different solutions. **Mastronardi** is directed towards centralized management of jukeboxes, noting "*the purpose of this invention is to overcome the disadvantages of prior art by proposing a device for management of audiovisual information reproduction systems that can be used to manage all information related to audiovisual information reproduction systems and their operation in a simple and centralized manner*" (**Mastronardi**, column 1, lines 31-36). In contrast, **Chiu** is directed to "*The present invention discloses methods and apparatuses for transferring data between digital processing systems. ... Normally, the first digital media is transmitted to the second digital processing system only if the first representation does not match any of the plurality of representations*" (**Chiu**, column 1, line 59 – column 2, line 6). Thus, one of ordinary skill in the art would not be motivated to combine these two references in the manner suggested by the examiner. The references can be combined only through the improper use of hindsight with the benefit of applicants' disclosure as a template to reach the presently claimed invention.

Thus, the rejection of claim 1 has been overcome. Claim 10 contains features similar to those of claim 1, so the rejection of claim 10 is also overcome. Additionally, the dependent claims recite further features not shown by the art relied on.

In particular, claim 18 recites the additional steps of "*wherein said terminal is a portable terminal having a music playback function, one or more downloading terminals are connected to said server via a network, and said determining means and said selectively downloading means are provided in said downloading terminal to perform said determination and said selective downloading by connecting to said downloading terminal said portable terminal or a storage medium to be loaded in said portable terminal*". The rejection asserts that this feature is shown in **Mastronardi**, column 1, lines 12-25, which states:

> International patent application WO 96/12255 describes a device for reproduction of audiovisual information commonly called jukebox. This jukebox is organized around a system unit that manages audiovisual reproduction means and means for memorizing at least one audiovisual information corresponding at least to the sound reproduction of one song. The system unit also manages telecommunication means such as a modem, particularly to enable downloading of audiovisual information from a host server. Management of orders for new songs and for changing settings requires either that an operator should visit the site on which the jukebox is installed, or that the operator should use a computer with a link to the host server.

> Furthermore, management operations that can be performed through the link with the host server are limited to ordering new musical selections.

There is nothing to suggest that the jukebox referred to in this excerpt is portable, or that the jukebox must be connected to a downloading terminal in order to receive downloads. Instead, the jukebox of **Mastronardi** is "installed", implying that it is a permanent or semi-permanent structure. Further, the jukebox of **Mastronardi** acts as a downloading terminal itself and does not need to be connected to a separate downloading terminal. Thus, this claim is separately allowable.

Therefore, the rejection of the claims under 35 U.S.C. § 103(a) has been overcome.

III. 35 U.S.C. § 103, Obviousness: Claims 1-19

Claims 1-19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over **Tsurumi** et al., Karaoke System Including Host Apparatus that Downloads Information File Based on List of Necessary Information Files, U.S. Patent No. 5,824,934, October 20, 1998 (hereinafter "**Tsurumi**") in view of **Shuster**, Method and System for Licensing a Copy of a Copyrighted Protected Work, U.S. Patent No. 6,826,546, November 30, 2004 (hereinafter "**Shuster**"). This rejection is respectfully traversed.

The rejection states on pages 6-7 of the Office Action dated November 28, 2005 that:

> 15. As per claim 10, Tsurumi discloses a music distribution method for downloading, in response to a request from a user (i.e.: a karaoke apparatus), music data for one more musical pieces (included in the latest hit charts from a server storing lot of music data ...col 3 lines 23-37 ... Tsurumi does not detail explicitly the server stored the latest hit charts. It was well-known in the music distributed system that the latest hit song or the favorite music could be selected and downloaded [see Shuster, col 1 lines 35-50; Tone, col 1- lines 17-35]

Office Action dated November 28, 2005, pages 6-7.

The determination of "nonobviousness" is made after establishing the scope and content of prior art, the differences between the prior art and the claims at issue, and the level of ordinary skill in the pertinent art. *Graham v. John Deere*, 383 U.S. 1 (1966). In addition, all limitations of the claimed invention must be considered when determining patentability. *In re Lowry*, 32 F.3d 1579, 1582, 21 U.S.P.Q.2d 1031, 1034 (Fed Cir. 1994).

The claims as amended also distinguish over **Tsurumi** and **Shuster**. Neither of these references disclose "*wherein said request contains a chosen number associated with a given latest hits chart*", as recited in claim 1. Neither do the references relied on disclose "*on said given latest hits chart, selecting musical pieces that have a numertcal ranking not greater than said chosen number*", as recited in claim 1.

Tsurumi notes:

> The large-capacity storage apparatus 2 also stores an information file list for each of the plurality of areas (see FIG. 4(A)). The information file list is a list of information files which are to be downloaded to a communication karaoke apparatus in each area. The contents of each list are updated as the occasion arises. When a newly released music file is to be downloaded, the host apparatus 1 receives the information file list of a communication karaoke apparatus (the list of information files stored in the communication karaoke apparatus at that time: see FIG. 3(A)), and compares the received list with the information file list of the host apparatus (see FIG. 4(A)). Then, only information files which are not included in the list from the communication karaoke apparatus are downloaded together with the newly released music file. At this time, the updated information file list is also downloaded (see FIG. 4(B)).

Tsurumi, column 3, lines 23-37, emphasis added

Schuster notes:

> In some cases, the protected works may be distributed using a centralized file sharing system, such as Napster. Napster is an application that allows users to easily search for and download their favorite music in the form of MP3 music files. Specifically, to search and download an MP3 music file, the user simply types in the name of an artist or song at the Napster.com website. The website then delivers a list of matching MP3 music files that are located on other users' computers. The user is then able to download a selected MP3 file by highlighting the particular file and clicking the "download" button. After completion of the download, the user is able to play the music on a computer or portable MP3 player. In view of the ability to download MP3 music files for free, many users opt to not purchase a copy of the music in CD or cassette tape format from an authorized retailer.

Schuster, column 1, lines 35-50, emphasis added.

Shuster discloses that the user can "*search for and download their favorite music*", but as noted in the underlined portions above, this patent teaches that the user must know the name of the song or the artist in order to search for popular music. **Tsurumi** downloads "newly released music file" (see underlined portion above), but does not appear to allow the user (karaoke machine) to request specific rankings. Instead, as the excerpt shows, the centralized apparatus

maintains a list of what will be played at each machine. Therefore, the rejection of claim 1 over **Tsurumi** and **Shuster** is overcome. Additionally, claim 10 contains similar features to claim1 and the rejection of this claim is overcome. Claims 3-6 and 8-9 are dependent on claim 1 and claims 12-18 are dependent on claim 10, so the rejection of these claims is also overcome.

Additionally, one of ordinary skill in the art would not combine the references when they are considered as a whole. In considering the references as a whole, one of ordinary skill in the art would look at the problems recognized and solved. **Tsurumi** is directed towards avoiding the wasted time when information is downloaded that is not needed, noting "*Some information files such as a CM which is to be displayed only in specific areas are necessary only for some areas and unnecessary for other areas. However, a conventional host apparatus downloads a superset containing all music-piece files and all information files to any communication karaoke apparatus, so that unnecessary information files are downloaded so as to waste time. As a result, the operation efficiency of the host apparatus is disadvantageously deteriorated, and a waste communication cost is introduced*" (**Tsurumi**, column 1, lines 24-33). In contrast, **Shuster** recognizes problems with dissemination of copyrighted material and the purchase of licenses for a downloaded file, noting "*The distribution system described above [e.g., Napster] provides many advantages and disadvantages for consumers and copyright owners. The advantages include distribution of copyrighted works to a vast audience at no cost or relatively little cost to the copyright owner. ... However, the above distribution system is economically harmful to copyright owners ... it would be desirable to provide a method and system that realizes the advantages of a costless distribution system, and which also promotes compliance with the copyright laws*" (**Shuster**, column 1, line 63 – column 2, line 31). These two problems are entirely unrelated and one of ordinary skill in the art would not be motivated to combine these two references when they are read a whole. As further support, the two cited references provide entirely different solutions. **Tsurumi** is directed towards determining before transmission that files are not needed, noting "*The host apparatus stores lists of information files which are necessary for respective communication karaoke apparatuses or for respective areas where the communication karaoke apparatuses are located. ... the download of waste information files can be eliminated so that the operation efficiency of the host apparatus is enhanced and communication time is saved*" (**Tsurumi**, column 2, lines 24-44). In contrast, **Shuster** provides a simple means of licensing a file, noting, "*In accordance with the teachings of the present*

invention, a method and system are provided for facilitating the purchase of a license for a downloaded file of a copyrighted work" (**Shuster**, column 2, lines 34-37). Thus, one of ordinary skill in the art would not be motivated to combine these two references in the manner suggested by the examiner. The references can be combined only through the improper use of hindsight with the benefit of applicants' disclosure as a template to reach the presently claimed invention.

Therefore, the rejection of claims 1-19 under 35 U.S.C. § 103(a) has been overcome.

IV. 35 U.S.C. § 103, Obviousness: Claims 1-19

The examiner has rejected claims 1-19 under 35 U.S.C. § 103(a) as being unpatentable over **Mastronardi** in view of **Shuster**. This rejection is respectfully traversed.

The examiner states on pages 9-10 of the Office Action dated November 28, 2005 that:

> 26. As per claim 1, Mastronardi discloses a music distribution method for downloading, in response to a request from a user, music data for one more musical pieces (i.e.: songs) included in the latest hit charts (i.e.: an album) ... Mastronardi does not explicitly detail determining whether music data to be downloaded from said server are already stored in a terminal said user and downloading, from said server to said terminal, only music data that are not stored in said terminal.
>
> In the same endeavor, Shuster discloses the music distributed system that the latest hit song or the favorite music could be selected and downloaded [Shuster, col 1 lines 35-50].
>
> Therefore it would have been obvious to an ordinary skill in the art at the time the invention was made to take advantage of the search, comparing or matching and selected music as taught by Shuster into the Mastronardi's apparatus in order to utilize the download process. Doing so would eliminate the transfer data unnecessary between client and server.

Office Action dated November 28, 2005, pages 9-10.

It is not clear what the Examiner is trying to say in this rejection. The rejection acknowledges that **Mastronardi** does not show downloading "*only music data that are not stored in said terminal*". The rejection does not even assert that **Shuster** shows this feature, but mentions that Shuster show the selection of favorite songs. The feature of downloading "*only music data that are not stored in said terminal*" is not addressed any further. Therefore, on the face of it, this rejection is not a proper statement of *prima facie* obviousness. The Examiner should clarify this rejection so that Applicants can properly respond.

However, it is noted that, as discussed in the two rejections above, neither **Mastronardi** nor **Shuster** discloses "*wherein said request contains a chosen number associated with a given latest hits chart*", as recited in claim 1. Neither do these references disclose "*on said given latest hits chart, selecting musical pieces that have a numerical ranking not greater than said chosen number*", as recited in claim 1.

Therefore, the rejection of claims 1-19 under 35 U.S.C. § 103(a) has been overcome.

V. New Claims

Newly added claim 20 recites:

> 20. (New) A method of distributing music from a server to a user device, comprising the steps of:
>
> receiving a request from the user device for downloading a set of musical pieces that have numerical rankings in the latest hit charts between 1 and a given ranking;
>
> comparing a latest hit chart maintained by the server and a latest hit chart stored on the user device to create a first list of musical pieces, wherein the first list contains musical pieces that are on the latest hit chart of the server but not on the latest hit chart of the user device and that have a numerical ranking in the latest hit chart of the server at a given ranking or less; and
>
> downloading, from the server to the user device, only musical pieces that are on the first list.

This claim provides further distinctions over the references relied. Specifically, both **Mastronardi** and **Tsurumi** are directed to managing music distribution when the server is the controlling force, i.e., a central server maintains lists of the music available at various sites and determines new songs to be added at each site. In contrast, the invention recited in claim 20 is user driven. The user device is not under the control of the central server, but under the control of the user, who decides the songs that they want to have on their device. The user is able to request "*a set of musical pieces that have numerical rankings in the latest hit charts between 1 and a given ranking*", i.e., a top hits list. Additionally, because the server is not responsible for the content of the user's device, it does not maintain a list of what the user device contains. The comparison to determine hit songs that the user does not have necessarily entails a determination of the songs the user device already contains, such as a comparison to "*a latest hits chart stored on the user device*". Both **Mastronardi** and **Tsurumi** maintain a centralized list of the songs stored at each location so modifying these references to meet this feature of claim 20 would run

counter to the central control maintained in the distribution systems of these references. Further, claims 21 and 22 are dependent on claim 22, so they also contain subject matter that distinguishes over these references.

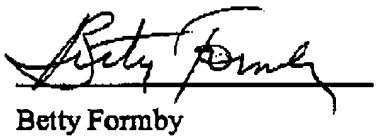
VI. Conclusion

It is respectfully urged that the subject application is patentable over the cited references and is now in condition for allowance.

The examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

DATE: February 8, 2006

Respectfully submitted,



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